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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/073,894	02/14/2002	Akinori Iwase	065905-0249	6723

22428 7590 04/24/2003

FOLEY AND LARDNER
SUITE 500
3000 K STREET NW
WASHINGTON, DC 20007

EXAMINER

NGUYEN, THU V

ART UNIT	PAPER NUMBER
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3661

DATE MAILED: 04/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/073,894

Applicant(s)

IWASE ET AL.

Examiner

Thu Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

The preliminary amendment filed on February 14, 2003 has been entered. By this amendment, the specification has been amended, claims 1-22 are now pending in the application.

Information Disclosure Statement

1. The listing of references in the specification page 3 is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Specification

2. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 9-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- a. In claim 9, line 4; claim 10, line 4, the claimed “it is” is ambiguous, it is not clear if “it” implies the “current time” or if “it” implies the “map data” that is directed by the user.
- b. In claim 11, line 5, the claimed “it is” is ambiguous as explained above.
- c. In claim 11, line 7-11 the lengthy sentence “when the map data ... the recording medium” is unclear. It is not clear which element that “forms the map data”.
- d. In claim 12, line 4; claim 13, line 5 the meaning of the “prescribed point” is ambiguous. It is not clear the “prescribing point” is an executable piece of software code, or if the “prescribing point” is a certain time period, or if “prescribing point” implies the area that stores the destination data.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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6. Claims 1-2, 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wiener (U.S Patent No. 6,490,521) in view of Ito (U.S Patent No. 6,347,278).

As per claim 1, 2, Wiener teaches an image forming system comprising: a portable terminal connected to a network that transmit a desired destination to a server, and an image forming apparatus that receive map data and forms a map image on a display (col.3, lines 30-50; col.4, lines 1-14)

Weiner does not explicitly teach storing a destination data and forming a map image data on a recording medium. However, since Wiener teaches that the central processing of the portable terminal forms a map to be displayed (col.4, lines 38-42), and further, it has been well known that the central processing unit must store the map to a buffer ready for displaying the image of the map, Wiener obviously teaches storing the map image on the recording medium as claimed. Further, Ito teaches storing the destination data to a prescribed area (col.17, lines 59-65). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to store destination taught by Ito in the server of Wiener in order to save memory size for the portable device and to save the user from re-inputting the destination.

As per claim 14-15, refer to claims 1, 2 above.

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7. Claims 3-8, 12-13, 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wiener (U.S Patent No. 6,490,521) in view of Ito (U.S Patent No. 6,347,278) and further in view of Machii et al (U.S Patent No. 6,324,467).

As per claim 3-8, 12-13, 16-19, Machii teaches storing a user information at a location corresponding to the user ID (col.11, lines 25-27), and charging service to the user (col.11, lines 25-32), and deleting the destination (col.15, lines 20-23). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to store the destination data of Ito to the location corresponding to user ID. Further, with respect to claims 7-8, charging a sponsor instead of charging the user, and including advertising messages of the sponsor, informing the user of the deleting of a stored information would have been well known.

8. Claims 9-11, 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wiener (U.S Patent No. 6,490,521) in view of Ito (U.S Patent No. 6,347,278) and further in view of Takayama et al (US 2001/0056443).

As per claim 9-11, 20-22, Takayama teaches allowing the user to set the time of departure (paragraph [0358], [0361], [0398],[0416]-[0421]). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to allow the user of Weiner to specify the departure time in order to facilitate planning for the navigation before the actual travel.

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Cited Prior Arts

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Takayuki (JP 11-064027) teaches scheduling the travel.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 305-7687, (for formal communications intended for entry)

Or:

(703) 305-7687 (for informal or draft communications, please label

"PROPOSED" or "DRAFT")

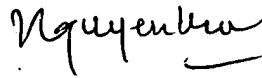
Hand-delivered responses should be brought to Crystal Park V, 2451 Crystal Drive,
Arlington, VA., Seventh Floor (Receptionist).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thu Nguyen whose telephone number is (703) 306-9130. The examiner can normally be reached on Monday-Thursday from 8:00 am to 6:00 pm ET.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Cuchlinski, can be reached on (703) 308-3873. The fax phone number for this Group is (703)305-7687 .

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703)308-1111.



Thu Nguyen

April 17, 2003